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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Frampton E. ELLIS, III**

Serial No.: **09/527,019**

Group Art Unit: **3728**

Filed: **March 16, 2000**

Examiner: **Anthony Stashick**

For: **REMOVABLE ROUNDED MIDSOLE STRUCTURES AND
CHAMBERS WITH COMPUTER CONTROLLED
PROCESSOR-CONTROLLED VARIABLE PRESSURE**

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Honorable Commissioner of
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Sir:

REPLY BRIEF

This is an appeal from the Final Rejection dated April 23, 2003, (hereinafter "the Final Rejection"). This Reply Brief responds to new issues raised by the Examiner in the Examiner's Answer mailed on October 15, 2003 (hereinafter "the Examiner's Answer").

I. First New Issue

The Examiner, at page 16 of the Examiner's Answer, for the first time took the position that,

“There is no notation in WO ‘612 that states that the midsole and outsole are permanently affixed to one another.”¹ The Examiner then suggests that the rejection of the claims of Group I under 35 U.S.C. §102(a) should be affirmed, presumably because there is no express statement in WO ‘612 that refers specifically to the midsole being “permanently affixed” to the outersole.

This reasoning is flawed since the WO ‘612 reference teaches means for attaching the midsole to the outersole, such as stitching and adhesives, which result in permanent affixation of the midsole to the outersole. Thus, the fact that WO ‘612 does not use the words, “permanently affixed” is not relevant since WO ‘612 teaches the skilled person to stitch or glue the midsole to the outersole, which necessarily results in permanent affixation of the midsole to the outersole.

Another problem with the Examiner’s reasoning is that he is giving the present claim language an unreasonably broad interpretation. More specifically, the Examiner is reading the word, “removable” to cover any shoe structure that can possibly be taken apart, even if it renders the shoe structure unsuitable for its intended purpose. This is clearly an unreasonably broad interpretation of the word, “removable” since it is clearly not the intention of the applicant in the present application to cover destruction of the shoe by use of the term, “removable.” This is readily apparent from a reading of the specification which describes, for example, the use of releasable attachment means as one embodiment for making the midsole removable from the outersole.

Finally, and more importantly, it is clear error for the Examiner to interpret WO ‘612 as teaching a removable midsole section when WO ‘612 states that a strong bond between the midsole and outersole is desired. See page 12, lines 20-22 of WO ‘612.

II. Second New Issue

With respect to Group V of the claims (claims 25-31), the Examiner, for the first time, took the position that,

¹ The Examiner continues to refer to International patent application publication no. WO 97/46127 as “WO ‘612.”

“The protrusions on at least one side of the removable midsole would be protrusions 74, 76, 78 of WO ‘612 and the outer surface of each of these protrusions are [sic] formed by the midsole, the shoe of WO ‘612.”

Examiner’s Answer at page 18. The first problem with this statement is that the Examiner improperly deems the entire shoe of WO ‘612 to be the midsole as claimed in claims 25-26. This is erroneous since the term, “midsole” has a well-recognized meaning in the art and clearly refers to a portion of the sole of a shoe, and not to an entire shoe as the Examiner suggests in the final clause of this quotation. This is also erroneous since WO ‘612 defines the portion of the shoe sole that is to be considered the midsole and the Examiner has offered no facts, evidence or arguments for disregarding the definition of the portion of the sole that is midsole given in WO ‘612.

The second problem with this statement is that since the Examiner designates the entire shoe of WO ‘612 as being the structure which corresponds to the “removable midsole section” of claims 25-31, the claimed “outer surface of the removable midsole section” must then correspond to the outer surface of the entire shoe of WO ‘612. As a result, the outer surface of protrusions 74, 76 and 78 of WO ‘612 does not form the outer surface of the removable midsole section, as claimed, since the outer surface of protrusions 74, 76 and 78 of WO ‘612 do not form part of the outer surface of the shoe of WO ‘612. Rather, as can be clearly seen in Figs. 19-21 of WO ‘612, the protrusions 74, 76 and 78 are located in the interior of the shoe of WO ‘612 and thus the protrusions 74, 76 and 78 do not form part of the outer surface of the shoe of WO ‘612. Therefore, since the Examiner has deemed that the entire shoe of WO ‘612 is the structure that corresponds to the claimed removable midsole section of claims 25-31, it is clear that the shoe of WO ‘612 does not meet the limitation of claims 25-31 requiring that the outer surface of the removable midsole section be formed by midsole since the outer surface of the entire shoe of WO ‘612 is not formed by midsole, but rather is formed by outersole.

This is the same reference as the Applicant designated “Adidas AG” in the appeal brief.

III. Third New Issue

At page 19 of the Examiner's Answer, when addressing Group VI (claim 32), the Examiner takes the position that once the shoe of WO '612 is placed within an overshoe, this magically changes the outer sole of the shoe of WO '612 into a midsole. The Examiner also alleges that the overshoe then becomes the outer sole. This is clearly wrong since the overshoe is still an overshoe no matter whether it is placed on the outside of another shoe or not. Moreover, the outer sole of the shoe of WO '612 remains an outer sole when the shoe of WO '612 is placed in an overshoe.

WO '612 clearly defines which portions of the shoe sole are the midsole and the outersole. The Examiner has presented no evidence whatsoever that a skilled person would ignore the teachings of WO '612 and re-designate the outer sole as a midsole when the shoe of WO '612 is placed in an overshoe. In reality, the skilled person would not do this and would still refer to the outersole of WO '612 as an outersole, and the midsole of WO '612 as a midsole, whether the shoe of WO '612 is located in an overshoe or not. Thus, the Examiner's reasoning should be rejected.

IV. Fourth New Issue

On page 21 of the Examiner's Answer, when addressing Group II (claims 12-13), the Examiner takes the position that, "The only requirement by [sic] the claims is that the controller be located within the upper, which is clearly taught by Demon." This statement is wrong since claim 12 locates the controller in the inner shoe and claim 13 locates the controller in the upper portion of the midsole. Thus, neither of claims 12-13 requires that the controller be located within the shoe upper as the Examiner alleges. Thus, the Examiner's reasoning with respect to claims 12-13 must fail for this reason in addition to those set forth in the Appeal Brief.

V. Fifth New Issue

On page 21 of the Examiner's Answer, the Examiner takes the position with respect to the

claims of Group II (claims 12-13) that,

“This argument is not clearly understood, although it may be difficult, the combination can be done...”

This quotation clearly demonstrates that the Examiner’s rejection is based on the misconception that if a combination of two references can be made, an obviousness rejection is appropriate. The correct legal standard to apply is whether a person of ordinary skill in the art would make the combination not whether a person of ordinary skill in the art could make the combination. Thus, the fact that it would be extremely difficult to make the combination suggested by the Examiner is relevant to the issue of obviousness since this high degree of difficulty would lead a person of ordinary skill in the art not to make the combination even though it could possibly be done. Moreover, the Examiner has provided no evidence whatsoever showing a motivation to combine the teachings of Demon with WO ‘612. Thus, the Examiner’s rejection must fail for this additional reason.

VI. Sixth New Issue

On page 22 of the Examiner’s Answer, when addressing the statutory double patenting rejection, the Examiner takes the position that, “...taken in its broadest reasonable interpretation, the term “orthotic” can be applied to any material that is placed within the shoe that gives support to different parts of the foot, ...” This interpretation of “orthotic” is clearly wrong since the applicant, in the 09/588,629 application provided a special definition of the term, “orthotic” which is narrower than the definition that the Examiner is applying. Since the applicant can be his own lexicographer, the Examiner must apply the applicant’s special definition of the term, “orthotic” provided by the applicant, and not the definition that the Examiner is applying. When the proper definition of “orthotic” is applied, there is no statutory double patenting.

VII. Seventh New Issue

On page 23 of the Examiner's Answer, the Examiner states that, "Furthermore, a Statutory Double Patenting rejection does not require that the claims be 'identical' but that they are directed to the same invention and the claims have the same 'gist'." The Examiner offers no legal authority in support of this unsubstantiated statement. The reason for this is that the statement is wrong.

Specifically, a statutory double patenting rejection "should be used when the conflicting claims are identical or conceded by applicant to be not patentably distinct." See MPEP §822. *In re Vogel*, 422 F.2d 438, 441 (CCPA 1970), which states that same invention statutory double patenting requires "identical subject matter." An "inner shoe" and an "insertable midsole orthotic" are clearly distinguishable for the reasons given in the appeal brief and, thus, the claims of the present application and the claims of U.S. Application No. 09/558,629 do not relate to identical subject matter. Accordingly, the same invention double patenting rejection should be reversed.

VIII. Conclusion

Appellant respectfully submits that each of the rejections should be reversed, that all claims be allowed. Such a decision is respectfully solicited.

Respectfully submitted,


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